



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/723,331

11/28/2000

Manfred Jendick

P 275935 US-2002536

5541

909

7590

08/23/2004

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Ar

Office Action Summary	Application No.	Applicant(s)	
	09/723,331	JENDICK, MANFRED	
	Examiner	Art Unit	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 34-43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) 32, 33 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/23/01, 3/9/01,</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>7/15/01, 10/12/01,</u> | |

DETAILED ACTION

Claim Objections

1. Claims 26, 32, 33, 40 and 45 are objected to because of the following informalities:

In claim 26, "said guide element" has no proper antecedent basis in the claims since applicant has previously recited plural guide elements. It is not clear which guide element applicant is referring to.

Claim 32 does not appear to be entirely accurate. In this claim applicant recites that "each of said guiding elements comprises a mounting block. . .and is biased towards the channel." However, it appears from the disclosure that only the displaceable guide elements have a mounting block and are biased towards the channel.

In claim 33, line 1, it appears that "are" should actually be --is-- for proper grammar.

With respect to claims 40 and 45, the manner in which applicant is using the phrase "zero tolerance to a distance" is unclear.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 2854

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,476,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims resides in a “for use” type statement which carries no patentable weight in the claims. In other words, in claim 1 of U.S. Patent No. 6,476,349 applicant has recited “a device for guiding a strip of metal past a laser unit,” and in claim 25 of the present application applicant has recited “a device for guiding a continuous strip past a marking unit.” Regardless of what the device is used for, applicant is still reciting the same device in both claims.

Additionally, claim 1 of U.S. Patent No. 6,476,349 recites all the structure recited in claim 28 of the present invention.

4. Claims 26, 30, 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,476,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of U.S. Patent No. 6,476,349 recites all the structure recited in claims 26 and 30 of the present invention and only differs with respect to “for use” statements as mentioned above.

5. Claim 34 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,476,349.

6. Claim 35 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,476,349.

7. Claim 36 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,476,349.

8. Claim 37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,476,349.

9. Claim 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,476,349.

10. Claim 39 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,476,349.

11. Claim 40 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,476,349.

12. Claim 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,476,349.

Art Unit: 2854

13. Claim 42 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,476,349.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 25, 28, 29 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Komatsu (JP 7-53099).

With respect to claim 25, Komatsu discloses a device with a longitudinal channel that receives a strip 2 and is partly defined by guide elements 21 and 22 that abut the strip 2 from opposite sides as shown in Figure 3 of Komatsu. Guide element 22 is displaceable by pivoting on arm 25 and is biased by spring 28 towards the inside of the channel as shown in Figure 2 of Komatsu and mentioned in paragraph [0019] of the machine translation of Komatsu.

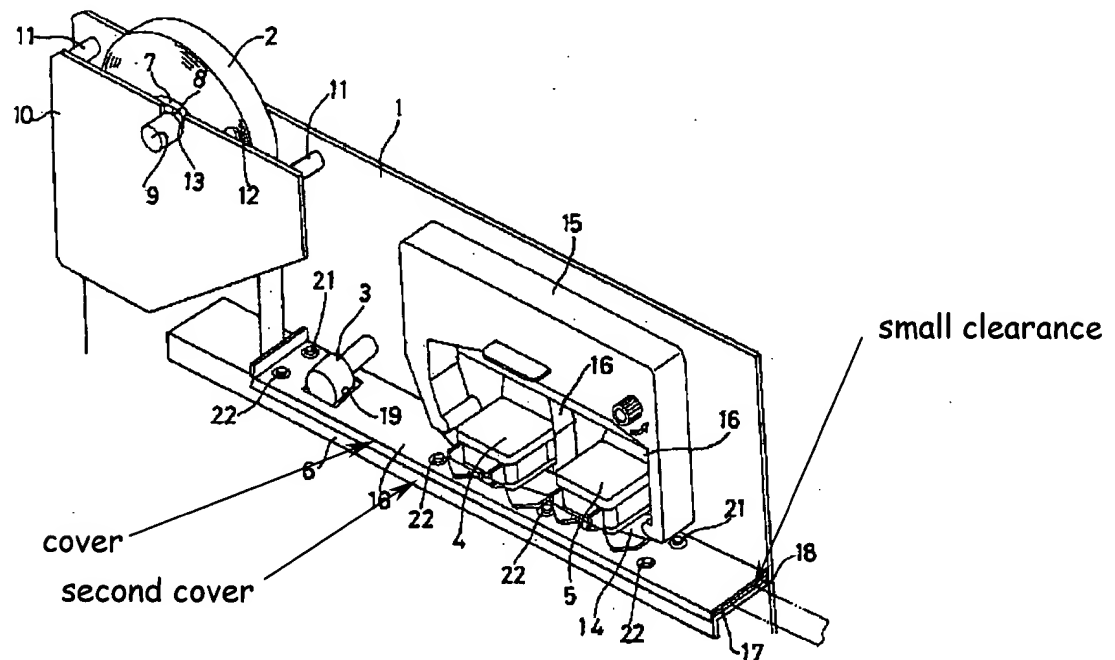
With respect to claim 28, the guide elements 21 and 22 are arranged to press against opposite longitudinal sides of the strip 2 as shown in Figure 3 of Komatsu.

With respect to claim 29, Komatsu discloses that guide elements 21 and 22 have a cylindrical portion and are supported to freely rotate (see machine translation of Komatsu, paragraph [0018]).

Art Unit: 2854

With respect to claim 34, Komatsu discloses a cover element 16 which is at least partially arranged between guiding elements 21 and 22. The cover element 16 provides a small clearance between it and the strip 2 as shown below in the Figure taken from Figure 1 of Komatsu:

【図1】



With respect to claims 35 and 37, Komatsu discloses openings 20 for allowing marking units to mark the strip 2 (paragraph [0016] of the machine translation).

With respect to claim 36, Komatsu discloses two cover elements 16 and 6 with a space between them to allow the strip 2 to pass through.

16. Claims 25-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Keyser (US 3,704,614).

Art Unit: 2854

With respect to claim 25, Keyser discloses a device including a longitudinal channel, formed by guide elements 58 and 48, bottom plate 31 and side plates 32 and 34. The guide elements abut the strip 21 on opposite sides and one guide element 58 is displaceable and biased against the strip as shown in Figure 3 of Keyser.

With respect to claim 26, each guide element has a surface portion (groove) that is pressed against the strip 21 and a shoulder portions above and below the groove as shown in Figure 7 of Keyser.

With respect to claim 27, the guide elements are freely rotatable bodies.

With respect to claim 28, the guide elements 48 and 58 press against the opposite longitudinal edges of the strip 21 as shown in Figure 3.

With respect to claim 29, the guiding elements 48 and 58 each comprise a freely rotatable body having a cylindrical portion (the groove) for abutting against the opposite longitudinal edges of the strips as shown in Figure 7 of Keyser.

With respect to claim 30, Keyser discloses a circumferential shoulder (the portions above and below the groove) for guiding the strip 21.

With respect to claim 31, the shoulders are arranged to guide portions of the opposite edges of the strip 21 as shown in Figure 7 of Keyser.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2854

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 38 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu (JP 7-53099) in view of Mason (US 5,813,782).

With respect to claim 38, Komatsu discloses the claimed device except for the intake assembly. However, Mason discloses a device with an intake assembly comprised of rollers 118 and 122 which engage the upper and lower surfaces of strip 13 as shown in Figure 6 of Mason. It would have been obvious to combine the teaching of Mason with the device disclosed by Komatsu for the advantage of relieving lateral stresses in the paper and reducing creases and puckers in the strip (Mason, abstract, last sentence).

With respect to claim 40, to the extent that this claim can be understood, it appears that Komatsu in view of Mason discloses all the claimed limitations. Rollers 118 and 122 must inherently include a certain amount of clearance so that strip 13 can pass between them.

With respect to claim 41, Mason discloses that the rollers 118 and 122 have laterally spaced radial projections 120 and 124, 125, 126, 127 respectively as shown in Figures 8, 10 and 15 of Mason.

19. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu (JP 7-53099) in view of Mason (US 5,813,782), as applied to claims 38, 40 and 41 above, and further in view of Thomas (US 3,087,665).

Komatsu in view of Mason discloses the claimed device except for the guiding shoulders on a spindle. However, Thomas teaches a strip spindle 11 with shoulders 26 and 27 separated by a distance that essentially corresponds with the width of the strip as shown in Figures 1-2 of

Art Unit: 2854

Thomas. It would have been obvious to combine the teaching of Thomas with the device disclosed by Komatsu in view of Mason for the advantage of keeping the strip aligned as it passes over the spindle.

20. Claims 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu (JP 7-53099) as applied to claims 25, 28, 29 and 34-37 above, and further in view of Suzuki (JP 9-208095).

With respect to claim 43, Komatsu discloses the claimed apparatus except for the outlet assembly. However, Suzuki teaches an outlet assembly including a first and second outlet rollers 70,30 and 68,28 respectively for abuttingly engaging the upper and lower surfaces of the strip 20 as shown in Figure 3 of Suzuki. It would have been obvious to combine the teaching of Suzuki with the device disclosed by Komatsu for the advantage of a driving force for removing the printed strip from the underneath the marking units 4 and 5.

With respect to claim 45, to the extent that this claim can be understood, it appears that Komatsu in view of Suzuki discloses all the claimed limitations. Rollers 70,30 and 68,28 must inherently include a certain amount of clearance so that strip 20 can pass between them.

With respect to claim 46, Suzuki discloses that the rollers 70,30 and 68,28 have laterally spaced radial projections 30 and 28 respectively as shown in Figure 3 of Suzuki.

21. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu (JP 7-53099) in view of Suzuki (JP 9-208095), as applied to claims 43, 45 and 46 above, and further in view of Thomas (US 3,087,665).

Art Unit: 2854

Komatsu in view of Suzuki discloses the claimed device except for the guiding shoulders on a spindle. However, Thomas teaches a strip spindle 11 with shoulders 26 and 27 separated by a distance that essentially corresponds with the width of the strip as shown in Figures 1-2 of Thomas. It would have been obvious to combine the teaching of Thomas with the device disclosed by Komatsu in view of Suzuki for the advantage of keeping the strip aligned as it passes over the spindle.

Allowable Subject Matter

22. Claims 32-33 are objected to as being dependent upon a rejected base claim and objected to for containing the above mentioned informalities, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and rewritten to overcome the above mentioned informalities.

23. Claim 39 would be allowable if rewritten to overcome the double patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

24. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2854

25. The following is a statement of reasons for the indication of allowable subject matter:

Claims 32-33 have been indicated as containing allowable subject matter primarily for each displaceable guiding element comprising a mounting block.

Claim 39 has been indicated as containing allowable subject matter primarily for the outlet rollers mounted for free rotation.


Claim 44 has been indicated as containing allowable subject matter primarily for the intake rollers mounted for free rotation.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 19, 2004


Daniel J. Colilla
Primary Examiner
Art Unit 2854